

REMARKSI. Introduction

In response to the Office Action dated October 1, 2003, claims 1-34 have been cancelled, and claims 35-68 have been added. Claims 35-68 remain in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Prior Art Rejections

The prior Office Actions and Advisory Action rejected the claims under 35 U.S.C. §103(a) as being unpatentable over Perlman, U.S. Patent No. 6,169,879 (Perlman) in view of PocketTV™ article (PocketTV™). In view of the prior arguments and Actions, the prior claims have been cancelled and replaced with new claims 35-68.

The new claims provide for displaying audio/visual information on an output device by using a set top box and hand held computing device. Specifically, the handheld computing device is used to control the set top box (similar to a remote control) and store audio/visual information. The new claims provide the ability for the handheld computing device to receive and store audio/visual information from the set top box and then transmit audio/visual information to the same (or different) set top box for display of the transmitted information on the output device. None of the prior art references, either alone or in combination, implicitly or explicitly, provide the ability for such a system or hand held computing device that performs such combined functionality as claimed.

With respect to specific aspects of the cited prior art, the PocketTV™ device is not equivalent to the claimed hand held computing device and does not perform or provide the same capabilities as claimed. The article states that the Palm-size PC becomes a miniature VCR. However, the information that follows in the article clearly illustrates that the PocketTV™ merely has the capability to display video on the Palm-size PC. In other words, the PocketTV™ is merely a TV that fits in your pocket (i.e., a pocket television). Further, the "VCR" capabilities cited in the article merely refer to the ability to play the content on the Palm-size PC. The fourth paragraph of the article further elaborates that the streaming video may be brought directly to "your pocket".

However, such streaming is not yet in the PocketTV device since the article states that usch streaming is available "as soon as wireless streaming reaches 100 Mbit/sec or higher bitrate..."

Thus, the PocketTV™ device is clearly limited to receiving non-streaming MPEG video from a PC and displaying it on the device itself.

In addition to the above, the PocketTV™ device does not provide the capability to send or receive information from a set top box. As described in the article, the device is limited to receiving and transmitting material to/from a computer. Such a limited amount of communication between a computer and the HP Jornada device is further illustrated in the portions of the HP Jornada User's Guide previously cited. Specifically, section 3 of page 8 provides for communication between the device and either a handheld PC, P/PC, and desktop PC. In this regard, there is no capability or suggestion, implicit or explicit that the PocketTV™ device may communicate with a set top box. Further, none of the cited references provide or even suggest a handheld computing device that has the capability to perform the combined functions of controlling a set top box and for storing and causing the display of audio/visual information as claimed.

The prior rejections also relied on the Perlman reference and equated Perlman's VCR to the claimed handheld computing device. Specifically, the Office Action states that is arguable that the VCR [130] may be broadly construed as being a handheld computing device, insofar as it is feasible that at some point in time it may be "hand held" while the carrier moved.

Applicant specifically traverses the assertion that Perlman's VCR [130] may be broadly construed as being a handheld computing device since at some point in time the VCR may be "handheld" while be carried or moved. Carrying or moving a VCR from one house to another is not even remotely similar to stating that the VCR is a handheld computing device. The background of the invention on page 2, line 27-page 3, line 19 describes handheld computing devices.

In addition, page 7, lines 11-18 specifically define the handheld computing device as claimed:

In accordance with one or more embodiments of the invention, the set top box 110 is controllable by a handheld computing device or PDA 114. As described herein, a handheld computing device, is any small device that maintains the ability to performed the functionality described with respect to the present invention. Such devices include but are not limited to devices that are configured to receive, transport, or store information or perform computations, calculations, etc. Alternatively, or in addition to controlling set top box 110, PDA 114 may provide for the storage and playback of information transmitted from set top box 110.

Nowhere in any of the text of the specification is there any reference, suggestion, or teaching, implicitly or explicitly, that the handheld computing device (as claimed) is even remotely similar to a standard VCR of Perlman and as suggested in the Office Action. Perlman's VCR is not a small device. Further, Perlman's VCR is not handheld. The only time the Perlman VCR is handheld is when it is being held by someone's hands while being moved or transported from one physical location to another physical location where it may be plugged into an AC outlet and a television or a hub and spoke configuration as described in Perlman. Suggesting that a VCR is equivalent to a handheld computing device is not only contrary to that stated in the present specification, but is contrary to the term handheld computing device as commonly used. In this regard, the American Heritage dictionary defines the term "handheld" as follows:

hand-held also **hand held** (hănd'hôld')

adj.

Compact enough to be used or operated while being held in the hand or hands: *a hand-held video camera.*

Source: *The American Heritage® Dictionary of the English Language, Fourth Edition*

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Clearly, Perlman's VCR is not compact enough to be used or operated while being held in the hand or hands. Instead, it is only "handheld" when it is being moved or carried. In this regard, even the Office Action provides that the only way that the Perlman VCR is a handheld computing device is that it may at some point in time be "handheld" while being carried or moved. Accordingly, it is clear that Perlman completely fails to teach that handheld computing device aspect of the invention as claimed.

In addition to the above, Applicant submits that the PocketTV article cannot be combined with the Perlman reference. The PocketTV article merely describes how a handheld or palm-sized PC is capable of playing back MPEG clips on the palmPC itself. In this regard, the article cites the use of the Casio Cassiopeia E-105 or HP Jornada 430se. However, as described above, these devices are limited to communication with a PC. There is no suggestion, implicit or explicit for

receiving audio/visual information or transmitting audio/visual information to a set top box and not a PC. Further, the article fails to provide a method of controlling a set top box via user commands.

Perlman provides a method for interconnecting a home entertainment system. Perlman completely fails to describe, implicitly or explicitly, the integration or use of any hand held computing device that has both the capability to control a set top box and store and transmit audio/visual information as claimed. Instead, Perlman merely describes how a remote control device can be used to send signals to an ASIC within the central electronics device 40 (see col. 8, lines 33-39). In this regard, none of Perlman's consumer electronics devices are even remotely similar to (nor do they allude to) a handheld computing device or palm pc device as claimed.

Thus, the above descriptions provide that the PocketTV™ article provides for using a palm PC to playback video, while Perlman provides for a central electronics device that may be operated using a remote control. There is no suggestion, implicit or explicit, to combine these features into a single unit. Nor is there any suggestion that the PocketTV article may be used for anything other than displaying audio/visual information on the device itself or potentially storing the information on a PC. Nor is there any suggestion, implicit or explicit, to use the PocketTV™ device in Perlman's configuration. In this regard, the two references cannot be combined with each other. To combine such references in view of the claimed invention would be to use hindsight. Under MPEP 2141.01, The requirement "at the time the invention was made" is to avoid impermissible hindsight. Stating that it would be obvious to use a PalmPC to both control a set top box and store and playback audio visual information through the set top box would be to use such impermissible hindsight provided by the claimed invention.

In view of the above, Applicant submits that none of the cited references teach, disclose, or suggest, implicitly or explicitly, either alone or in combination, the present claims. In addition, the new dependent claims provide additional subject matter that is clearly not described in any of the cited references. For example, the prior art fails to describe the depression of a single button on a handheld computing device that causes both the transmission of audio/visual material to the set top box and the playback of the audio/visual information on an output device by the set top box (see dependent claims 38, 49, and 60). Further, the prior art fails to provide limitations regarding when the audio visual information is transmitted from the set top box to the hand held computing device as recited in claims 43-46, 53-56, and 65-68.

III. Conclusion

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

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